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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Joseph J. Kubler

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EXAMINER

ROBERTS, BRIAN S

ART UNIT

PAPER NUMBER

2466

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/760,035	<b>Applicant(s)</b> KUBLER ET AL.	
	<b>Examiner</b> BRIAN ROBERTS	<b>Art Unit</b> 2466	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/22/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-34,36-38,54-59 and 78-133 is/are pending in the application.
- 4a) Of the above claim(s) 96-121 and 130-133 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-34,36-38,54-59,78-95 and 122-129 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

- Claims 22-34, 36-38, 54-59, 78-133 remain pending.
- Claims 96-121 and 130-133 have been withdrawn from consideration.

### ***Specification***

The amendment filed 07/22/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

"Fig. 64 is a diagram which illustrates additional detail of a portable terminal device that may correspond to, for example, the terminals illustrated in Fig. 46b and the terminals illustrated in Fig. 55a, in accordance with a representative embodiment of the present invention."

"Fig. 64 is a diagram which illustrates additional detail of a portable terminal device 6400 that may correspond to, for example, the terminals 4664, 4667 illustrated in Fig. 46b and the terminals 5521, 5523, 5555, 5581 illustrated in Fig. 55a, in accordance with a representative embodiment of the present invention. As shown in Fig. 64, an embodiment of such a terminal may comprise RF transceiver A 6401, RF transceiver B 6403, conversion circuitry 6420, and an interface slot 6421. The RF transceiver A 6401 and RF Transceiver B 6403 may correspond to, for example, the RF transceiver 3110 illustrated in Fig. 30. The conversion circuitry 6420 of Fig. 64, which may correspond, for example, to the conversion circuitry illustrated in Fig. 58, comprises control

Art Unit: 2466

processing circuit 6401, a microphone 6405, a speaker 6407, a microphone/phone processing circuit 6409, an A/D conversion circuit 6417, a D/A conversion circuit 6415, a queue time buffer 6413, and an output buffer 6419. These elements of conversion circuitry 6420 may correspond, for example, to the control processing circuit 5801, microphone 5805, speaker 5807, microphone/phone processing circuit 5809, A/D conversion circuit 5817, D/A conversion circuit 5815, queue time buffer 5813, and output buffer 5819, respectively, of Fig. 58. Because these elements are described above with respect to Fig. 58, they will not be described again here. The interface slot 6421 may interface to an RF transceiver C 6423 that may be, for example, compatible with a PCMCIA standard. The RF transceiver C 6423 may support cellular communication."

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Drawings***

The drawings are objected to because Figure 64 contains new matter. The original disclosure does not support a single embodiment of a portal terminal containing all the elements of Figure 64. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as

Art Unit: 2466

“amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-34, 36-38, 54-59, 78-95, and 122-129 are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- In reference to claim 22

Art Unit: 2466

In claim 22 lines 13-15, the limitation "a second receiver supporting a short range wireless communication link, the portable terminal device transmitting, via the wireless packet network, digital voice packets created using digitized voice information received by the second receiver" was not described in the original disclosure, and thus constitutes new matter. Furthermore, in lines 16-22, the limitation " wherein the portable terminal device evaluates a message wirelessly received from the base station and sends to the base station an indication of a data rate based on the evaluation; and wherein the portable terminal device receives digital voice packets transmitted by the base station at a data rate selected by the base station based upon the indication of a data rate" was not described in the original disclosure, and thus constitutes new matter.

- In reference to claim 30

In claim 30 lines 9-11, the limitation "a second receiver supporting a short range wireless communication link, wherein the portable terminal device transmits, via the wireless packet network, digital voice packets created using digitized voice information received by the second receiver" was not described in the original disclosure, and thus constitutes new matter. Furthermore, in lines 13-18, the limitation " wherein the circuit evaluates a message wirelessly received from the base station and sends to the base station an indication of a data rate based on the evaluation; and wherein the circuit receives digital voice packets transmitted by the base station at a data rate selected by the base station based upon the indication of a data rate" was not described in the original disclosure, and thus constitutes new matter.

- In reference to claim 54

In claim 54 lines 13-17, the limitation "receiving digitized voice information using a short range wireless communication link; creating digital voice packets from the digitized voice information; sending the digital voice packets via the wireless packet network" was not described in the original disclosure, and thus constitutes new matter. Furthermore, in lines 20-23, the limitation "wherein the portable terminal device receives sender of the received digital voice packets at a selects the data rate selected by a base station serving a plurality of portable terminal devices, based upon the indication of a data rate sent by the portable terminal device" was not described in the original disclosure, and thus constitutes new matter.

- In reference to claim 78

In claim 78 lines 15-19, the limitation "receiving digitized voice information using a short range wireless communication link; creating digital voice packets from the digitized voice information; sending the digital voice packets via the wireless packet network" was not described in the original disclosure, and thus constitutes new matter. Furthermore, in lines 22-25, the limitation "wherein the portable terminal device receives digital voice packets at a data rate selected by a base station serving a plurality of portable terminal devices, based upon the indication of a data rate sent by the portable terminal device" was not described in the original disclosure, and thus constitutes new matter. "Computer-readable medium" and the limitation "A computer-readable medium,

Art Unit: 2466

having stored thereon a computer program having a plurality of code sections for operating a portable terminal device supporting voice communication via a wireless packet network, the code sections executable by a processor for causing the processor to perform the operations" was disclosed or defined in the original disclosure, thus the limitation is considered new matter.

- In reference to claims 22-29, 31-34, 36-38, 55-59, 79-95, and 122-129

Claims 22-29, 31-34, 36-38, 55-59, 79-95, and 122-129 are rejected as being dependent on a rejected base claim.

### ***Response to Arguments***

Applicant's arguments filed 02/17/2009 have been fully considered but they are not persuasive.

- In the Remarks on pg. 22-36 of the Amendment, the applicant contends that claim 22, and similarly claims 30, 54, and 78, do not constitute new matter, and are in compliance with 35 U.S.C 112, first paragraph. In support of the claims, the Applicant cites: pg. 28 lines 4-15, pg 31 line 17 - pg. 12, pg. 189 lines 9-16, pg. 151 line 3 - pg. 153 line 6, pg 135 line 12 - pg. 136 line 5, pg 112 - 19 to pg 113 line 3, pg. 213 line 10-13, pg. 200 line 9-21, pg. 216 line 11 - pg 217 line 20, pg 217 line 14-16, pg 12 line 1-10, pg 258 line 6-15, pg 254, pg 218 line 17 - pg. 219 line 5, pg 263 lines 1-10, pg 291 line 11-13, Figure 58, pg 123 line 20 - pg 124 line 6, pg 27 line 13-15, pg 28 line 1-3, pg 39 lines



Art Unit: 2466

- 17-19, pg 69 lines 11-12, pg 75 lines 7-9, pg 69 lines 12-16, pg 70 line 10-15, pg 69 lines 15-16, pg. 75 line 9-12, pg 70 16-18, pg 12 lines 1-10, pg 258 lines 6-15, pg. 70 lines 20-22.
- The Examiner respectfully disagrees. With respect to claim 22, and similarly claim 30, the specification fails to support a single embodiment comprising all the claimed elements. The Applicant cites various aspects of several different embodiments to arrive at the claimed invention. However, the original disclosure does not recite a single embodiment containing ALL the claimed aspects of the claimed invention. Furthermore, the cited passages fail to support a method that corresponds to the method steps of claim 54, and similarly the operations of claim 78.
  - In the Remarks on pg. 37-44 of the Amendment, the Applicant contends that claim 78 does not constitute new matter, and is in compliance with 35 U.S.C 112, first paragraph. The applicants respectfully submits that the use of processors, memory, and software in portable terminals and other portable devices was known to those of ordinary skill in the relevant art at the time of the invention. It is not necessary, therefore, for Applicants' disclosure to teach the use of such elements in that their existence and the details of their interconnection and use was well known to those of ordinary skill in the relevant art at the time of the invention. The applicant cites US Patent 5414751, 5444869, 5369798 in support. Furthermore, the applicant cites pg 222 lines 3-5, pg 199 line 16 - pg. 201.

Art Unit: 2466

- The Examiner respectfully disagrees. The original disclosure fails to support the claimed operations. As such, the disclosure does not support a computer-readable medium having stored code sections executable by a processor for causing the processor to perform the claimed operations.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN ROBERTS whose telephone number is (571)272-3095. The examiner can normally be reached on M-F 10:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DANIEL RYMAN can be reached on (571) 272-3152. The fax phone

Art Unit: 2466

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSR

11/11/2009

/Daniel J. Ryman/

Supervisory Patent Examiner, Art Unit 2466